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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/338,855 | 06/23/99 | SORGE | J 04435/79243 |

HM12/0816

EXAMINER

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CHAKRABARTI, A

ART UNIT PAPER NUMBER

1655

DATE MAILED: 08/16/00 5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|------------------------|-----------------------|
| Office Action Summary | <i>Application No.</i> | <i>Applicant(s)</i> |
| | 09/338,855 | Sorge |
| | <i>Examiner</i> | <i>Group Art Unit</i> |
| | Arun Chakrabarti | 1655 |

Responsive to communication(s) filed on Jun 23, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-144 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

Claims 1-144 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some None of the CERTIFIED copies of the priority documents have been*

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to a method of enriching for and identifying a nucleic acid sequence by hybridization, classified in class 435, subclass 94.
 - II. Claims 4-25, drawn to method of identifying a nucleic acid sequence by using an enzyme, a classified in class 435 , subclass 6.
 - III. Claims 26-48,drawn to method of identifying a nucleic acid sequence by using an non-enzyme protein, classified in class 536 , subclass 25.3.
 - IV. Claims 49-74, drawn to a method of method of enriching for and identifying a nucleic acid sequence by using amplification reaction, classified in class 435, subclass 91.2+.
 - V. Claims 75-98, drawn to a method for accessing a sub-portion of a nucleic acid population, classified in class 536, subclass 22.1+ .
 - VI. Claims 99-144, drawn to a method for accessing a sub-population of a genome , classified in class 536, subclass 23.1+ .
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions of Group I and II-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the

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sequencing by hybridization of Group I is not disclosed as capable of use together with the sequencing by enzyme of Group II or with the method of sequencing by non-enzyme protein of Group III or amplification reactions of Group IV or with the method of accessing a sub-portion of a nucleic acid population of Group V or with the method for accessing a sub-population of a genome of Group VI. The sequencing by hybridization of Group I have different modes of operation, different functions, or different effects than the sequencing by enzyme of Group II or with the method of sequencing by non-enzyme protein of Group III or amplification reactions of Group IV or with the method of accessing a sub-portion of a nucleic acid population of Group V or with or with the method for accessing a sub-population of a genome of Group VI.

4. Inventions of Group II and III-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the sequencing by enzyme of Group II is not disclosed as capable of use together with the method of sequencing by non-enzyme protein of Group III or amplification reactions of Group IV or with the method of accessing a sub-portion of a nucleic acid population of Group V or with the method for accessing a sub-population of a genome of Group VI. The sequencing by enzyme of Group II have different modes of operation, different functions, or different effects than the method of sequencing by non-enzyme protein of Group III or amplification reactions of Group IV or the method of accessing a sub-portion of a nucleic acid population of Group V or the method for accessing a sub-population of a genome of Group VI.

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5. Inventions of Group III and IV-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the method of sequencing by non-enzyme protein of Group III is not disclosed as capable of use together with the amplification reactions of Group IV or with the method of accessing a sub-portion of a nucleic acid population of Group V or with the method for accessing a sub-population of a genome of Group VI. The method of sequencing by non-enzyme protein of Group III have different modes of operation, different functions, or different effects than the amplification reactions of Group IV or the method of accessing a sub-portion of a nucleic acid population of Group V or the method for accessing a sub-population of a genome of Group VI.

6. Inventions of Group IV and V-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the amplification reactions of Group IV is not disclosed as capable of use together with the method of accessing a sub-portion of a nucleic acid population of Group V or with the method for accessing a sub-population of a genome of Group VI. The amplification reactions of Group IV have different modes of operation, different functions, or different effects than the method of accessing a sub-portion of a nucleic acid population of Group V or the method for accessing a sub-population of a genome of Group VI.

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7. Inventions of Group V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the method of accessing a sub-portion of a nucleic acid population of Group V is not disclosed as capable of use together with the method for accessing a sub-population of a genome of Group VI. The method of accessing a sub-portion of a nucleic acid population of Group V have different modes of operation, different functions, or different effects than the method for accessing a sub-population of a genome of Group VI.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. A telephone call was made to Kathleen Williams (617-573-0100) on August 3, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D., whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Arun Kr. Chakrabarti

Arun Chakrabarti,

Patent Examiner,

August 4, 2000

S. Ettemer
S. Ettemer
STEPHEN A. ETTEMER
PRIMARY EXAMINER